UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,300	02/26/2002	Naoki Tsuchitoi	03500.016242	2783

5514   7590   02/15/2008

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EXAMINER
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ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
02/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
	10/082,300	TSUCHITOI, NAOKI
Office Action Summary	Examiner	Art Unit	
	Peter K. Huntsinger	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 November 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*1-5 and 11-24*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>*1-5 and 11-24*</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 11/26/07 have been fully considered but they are not

persuasive.

The applicant argues on pages 12-14 of the response in essence that:

Mori '765 merely deletes the print data according to the fact that it becomes a

designated time, but does not determine whether each print data satisfies a specific

condition, according to the fact that it becomes the designated time.

a.   Mori '765 discloses determining whether each print data satisfies a

specific condition (S660 of Fig. 10, col. 14, lines 49-60, determines if there is a

job with an expired deleted time), according to the fact that it becomes the

designated time (col. 4, lines 56-65, user can preset a time indicating when to

delete print data). Whether the job has an expired delete time or not can be

considered the specific condition. This condition is dependent on checking that it

is the specific time specified by the user.

The applicant argues on page 15 of the response in essence that:

Taniguchi '972 fails to disclose according to a fact that it becomes a specific time, it is

determined whether or not each print data satisfies a specific condition and when it

becomes the specific time, the print data is not deleted if it does not satisfy the specific

condition.

b.   Taniguchi '972 discloses according to a fact that it becomes a specific

time, it is determined whether or not each print data satisfies a specific condition

(col. 10, lines 9-17, determines whether the job is regarded as stale). Whether

the print job is regarded as stale or not is dependent on the job effective term

entered by the user. In response to applicant's argument that the references fail

to show certain features of applicant's invention, it is noted that the features upon

which applicant relies (i.e., when it becomes the specific time) are not recited in

the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See

In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further,

Taniguchi '972 teaches multiple print job with their own job effective terms. When

the user specified job effective term expires for one print job, that print job will be

deleted while the other print jobs with later job effective terms will not.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-3, 5, 11-13, 15, and 21-24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Arledge '294 and further in view of Mori '765.

Referring to claims 1, 11, 21, 23, and 24, Arledge '294 discloses a printer

controller for controlling printing of print data comprising: a storage unit to store the print

data and authentication information corresponding to the print data (Information

Database 220 of Fig. 2, col. 9, lines 59-67); an input unit adapted to enable a user to

input authentication information to print the print data (Fig. 5, col. 13, lines 15-23); a

collation unit adapted to collate the authentication information input by the user with the

authentication information stored in said storage unit (col. 13, lines 23-32); a display

control unit adapted to, after the user inputs the authentication information, display a list

of print data corresponding to the input authentication information on a display panel

(Fig. 19, col. 19, lines 1-13); a selection unit adapted to enable the user to select at

least one print data from the list of print data displayed on the display panel (col. 19,

lines 11-13); and a control unit adapted to control the printing of the selected print data

to be performed after confirming that a print charge for printing the print data selected

by the user is paid (col. 21, lines 15-32).

Arledge '294 does not disclose expressly deleting a job at a user specified time.

Mori '765 discloses a check unit adapted to check whether it is a specific time

specified by the user (col. 4, lines 56-65, user can preset a time indicating when to

delete print data); a determination unit adapted to determine, in accordance with

checking that it is the specific time specified by the user, whether each of the print data

stored in said storage unit satisfies a specific condition (S660 of Fig. 10, col. 14, lines

49-60, determines if there is a job with an expired deleted time); and a deletion unit

adapted to delete, the stored print data which satisfies the specific condition and not to

delete the stored print data which does not satisfy the specific condition (S670 of Fig. 10, col. 14, lines 49-60, printer deletes corresponding job if job has expired delete time).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to delete a job after a user specified time. The motivation for doing so would have been to delete data that is no longer needed to obtain free storage space. Therefore, it would have been obvious to combine Mori '765 with Arledge '294 to obtain the invention as specified in claims 1, 11, 21, 23, and 24.

Referring to claims 2 and 12, Arledge '294 discloses print data stored in said storage unit, but does not disclose expressly assigning the print data a priority level.

Mori '765 discloses wherein each print data stored in a storage unit is given a priority level, a printer controller further comprising a deletion unit adapted to delete one of the stored print data which is given a low priority level upon detecting that said storage means cannot store the print data anymore (col. 4-5, lines 66-67, 1-10).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to assign a priority level to stored data. The motivation for doing so would have been to delete data that is less important when a storage unit is full. Therefore, it would have been obvious to combine Mori '765 with Arledge '294 to obtain the invention as specified in claims 2 and 12.

Referring to claims 3 and 13, Mori '765 discloses wherein the print data which is given the low priority level means the print data which was received earlier than any other print data received by said printer controller (col. 4-5, lines 66-67, 1-10).

Referring to claims 5 and 15, Arledge '294 discloses wherein said deletion unit determines that print data should be deleted if a predetermined period has passed after the print data is received by a print controller (col. 4, lines 56-65).

4.   Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arledge '294 and Mori '765 as applied to claims 2 and 12 and above, and further in view of Reifman '433.

Referring to claims 4 and 14, Mori '765 discloses a deletion unit adapted to delete print data, but does not disclose expressly notifying a destination address when print data is deleted.

Reifman '433 discloses notification means for notifying a destination address set up when an error occurs (col. 73, lines 64-67).

At the time of the invention, it would have been obvious to one of ordinary in the art to notifying a destination address when the print data is breached. The motivation for doing so would have been to alert the user when print data is no longer stored and available for printing. Therefore, it would have been obvious to combine Reifman '433 with Arledge '294 and Mori '765 to obtain the invention as specified in claims 4 and 14.

5.   Claims 16-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi '972 and further in view of Arledge '294.

Referring to claims 16 and 22, Taniguchi '972 discloses a data processing method for providing a print service using an information processing apparatus for

storing the print data and authentication information corresponding to the print data, and

a printer, comprising: a first transmission step of transmitting authentication information

input by a user to print the print data from the printer to the information processing

apparatus (S610 of Fig. 6, col. 7, lines 24-27); a display step of displaying a list of print

data corresponding to the input authentication information on a display panel of the

printer (S606 of Fig. 6, col. 7, lines 1-10); a third transmission step of transmitting at

least one print data selected by the user from the list of print data displayed on the

display panel from the information processing apparatus to the printer (S612 of Fig. 6,

col. 7, lines 34-39); a checking step of checking whether it is a specific time specified by

the user (col. 4, lines 43-49, user may enter job effective term for print job); a

determination step of determining, in accordance with checking that it is the specific

time specified by the user, whether each of the print data stored by the information

processing apparatus satisfies a specific condition (col. 10, lines 9-17, whether the job

effective term is passed); and a deletion step of deleting, the stored print data which

satisfies the specific condition and not to delete the stored print data which does not

satisfy the specific condition (col. 10, lines 9-17, if the job is regarded to be stale, the

print job is deleted).

Taniguchi '972 does not disclose expressly displaying a list of print data after the

user inputs the authentication information and charging for printing.

Arledge '294 discloses a second transmission step of transmitting information

identifying the print data corresponding to the input authentication information (col. 19,

lines 1-13); a display step of displaying, after the user inputs authentication information,

a list of print data corresponding to the input authentication information on a display

panel in accordance with the information transmitted in said second transmission step

(Fig. 19, col. 19, lines 1-13); and a control step of controlling the printer to perform the

printing of the print data after confirming that a print charge for printing the selected print

data is paid (col. 21, lines 15-32).

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to display a list of print jobs after a password has been entered and

charge for printing. The motivation for doing so would have been to protect information

of the user by only providing the print job list after a password has been entered and to

collect a fee for a provided service. Therefore, it would have been obvious to combine

Arledge '294 with Taniguchi '972 to obtain the invention as specified in claims 16 and

22.

Referring to claim 17, Arledge '294 discloses the request step of requesting the

selected print data of said information processing apparatus after confirming that the

print charge for printing the print data selected by the user is paid (col. 21, lines 47-57).

Referring to claim 18, Arledge '294 disclose wherein the information identifying

the print data is information indicating a name given to the print data corresponding to

the input authentication information (col. 13, lines 15-23).

Referring to claim 19, Taniguchi '972 discloses a fourth transmission step of

transmitting the information identifying the selected print data from the printer to the

information processing apparatus (S608 of Fig. 6, col. 7, lines 11-15) and a fifth

transmission step of transmitting the selected print data from the information processing

apparatus to the printer based on the information transmitted in said fourth transmission step (S612 of Fig. 6, col. 7, lines 34-39).

Referring to claim 20, Taniguchi '972 discloses a second deletion step of deleting print data printed in said control step from the printer after the end of printing the print data (S615 of Fig. 6, col. 7, lines 49-52).

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.
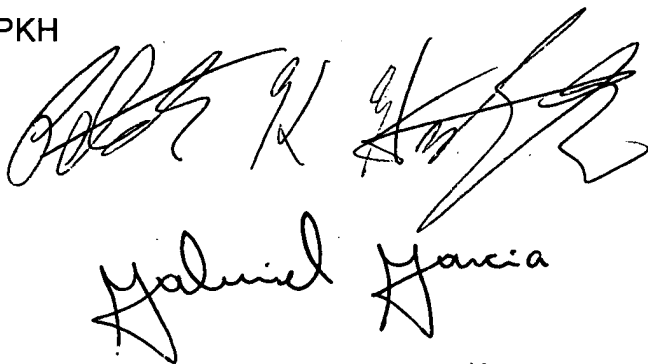
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH

GABRIEL GARCIA
PRIMARY EXAMINER